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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/052,204	01/15/2002	William C. Nowlin	017516-001320US	9117

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EXAMINER
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SHAW, SHAWNA JEANNINE

ART UNIT	PAPER NUMBER
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3737

DATE MAILED: 03/01/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<p align="center"><b>Office Action Summary</b></p>	Application No. 10/052,204	Applicant(s) NOWLIN ET AL.	
	Examiner Shawna J. Shaw	Art Unit 3737	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 06 December 2004.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-5 and 7-17 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5 and 7-17 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Response to Arguments*

1. Applicant's arguments filed 12/6/2004 have been fully considered but they are not persuasive. The examiner maintains that the operative association between the work station and the manipulator is interrupted upon activation of button (130) of Blumenkranz et al. which renders the instrument movable without any corresponding movement of the master controller. In response to applicant's argument that Blumenkarnz et al. does not teach activating and deactivating the repositioning system "while master controller is held in a substantially fixed position," a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). The examiner interprets claim 1 such that the selectively activatable repositioning system is configured to interrupt operative association and to reestablish the operative association.

Appliant's remarks arguing that the claimed subject matter is broadly claimed, not indefinite, have overcome the previous 112 rejections.

***Claim Interpretation/Definitions***

The examiner notes that the types of "interruptions" as disclosed by the present invention include: "clutching," repositioning of an endoscope, left-right tool swap, removal/replacement of a tool, *manual repositioning* of a tool, etc. (Specification page 33 lines 5-11).

The examiner further notes that suitable input devices for the "clutching" procedure of the present invention may include: finger buttons, foot pedals and voice input (Specification page 34 lines 1 and 2).

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 9-15 and 17 are rejected under 35 U.S.C. 102(e) as being anticipated by Wang et al. (5,762,458).

Wang et al. '458 disclose all of the claimed subject matter including a "clutching assembly" (input button, 58) so that when released ("first" mode), the input device (handle, 50, 52) can be moved while the surgical instrument (e.g., end effector, endoscope) is maintained substantially fixed. See col. 3 lines 43-67 and claims 1 and 6.

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3. Claims 9-15 and 17 are rejected under 35 U.S.C. 102(e) as being anticipated by Wang et al. (6,699,177).

Wang et al. '177 disclose all of the claimed subject matter including a "clutching assembly" (switch, 51) so that when in a "first" mode (as determined by a multiplexer), the input device (handle, 50, 52) can be moved while the surgical instrument (e.g., end effector, endoscope) is maintained substantially fixed (disabled). See col. 7 lines 25-35, col. 17 lines 2-9 and claim 1.

***Claim Rejections - 35 USC § 103***

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-5, 7 and 8 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Blumenkranz et al. of record.

Blumenkranz et al. teach a robotic surgical system including a surgical manipulator system (50) movably supporting at least one surgical instrument (54), such as an image capture device (col. 5 lines 57, 58, claim 25), in a plurality of degrees of freedom (fig. 2A); a master controller workstation and display (150); and a selectively activatable repositioning system (col. 3 lines 4-24, col. 10 lines 45-49) including an input device (130) to enable manual override of the manipulators where the instrument is physically *instead of* robotically moved. Although Blumenkranz et al. does not expressly state that the master controller is held in a "substantially" fixed position, Blumenkranz et al. does not disclose that substantial movement of the master controller takes place during the manual override. Alternatively, it is at least implied that the position of the master controller stays substantially the same during the manual override and where it would have been obvious at the time the invention was made to a person of ordinary skill in the art to keep the master controller in substantially the same position due to the nature of the problem as there would be no need to move it during the manual override and the operator would want to pick up where he left off (especially when manually repositioning because the instrument is out of the controller's range of movement) for reasons of accuracy and efficiency as is appreciated in the art. Blumenkranz et al. additionally teach a surgical tool (col. 5 lines 50-52) and wherein brakes (124) inhibit rotational motion about joints (84) (col. 10 lines 30-44).

***Allowable Subject Matter***

5. Claim 16 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

***Conclusion***

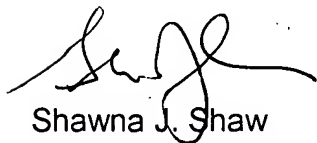
6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shawna J. Shaw whose telephone number is (571) 272-4743. The examiner can normally be reached on 6:45 a.m. - 3:15 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Brian Casler can be reached on (571) 272-4956. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Shawna J. Shaw  
Primary Examiner  
Art Unit: 3737  
02/23/2005